

**REMARKS**

Support for “a card substrate and a magnetic layer provided on said card substrate for magnetically recording information thereon in a machine-readable fashion and further comprising a volume hologram layer provided on said magnetic layer, wherein magnetic information on said magnetic layer is recorded or read through the volume hologram layer” in claim 1 as amended is found in Fig. 2, Fig. 4, and Fig. 6. Support for “magnetic information is recorded or read through the volume hologram layer” in claim 1 as amended is found at page 19, lines 6-14 of the specification. Support for “said volume hologram layer has a glass transition temperature of 50°C or higher, a breaking extension of 0.01% to 30% and a pencil hardness of 3B to 3H in a state with a hologram recorded thereon” is found at page 19, line 15 to page 20, line 4 of the specification.

Entry of the above amendment is respectfully requested.

**Priority Document**

On the Office Action Summary, the Examiner acknowledges Applicants' claim for priority and indicates that the certified copies of the priority documents have not been received.

In response, Applicants submit herewith the certified copies of the priority documents. An indication of receipt of the certified copies of the priority documents is respectfully requested.

**Rejection under 35 U.S.C. 112, First Paragraph**

On page 2 of the Office Action, in paragraph 2, claims 1-3 are rejected under 35 U.S.C 112, first paragraph, as failing to comply with the enablement requirements.

**The Examiner's Position**

The Examiner's position is that there is no enablement for recording magnetic information on or reading from the volume hologram layer. In particular, the Examiner indicates that the volume hologram layer does not contain magnetic material to enable this feature. Rather, the Examiner indicates that the magnetic layer to which magnetic information is recorded or read is remote from the volume hologram layer, and the information is recorded or read through the volume hologram layer.

**Applicants' Response**

In response to this rejection, and to expedite allowance, Applicants have amended the claims to change "recorded on or read from said volume hologram layer" to "recorded or read through the volume hologram layer", in accordance with the Examiner's indication.

Thus, Applicants submit that the present claims satisfy the requirements of 35 U.S.C. 112, first paragraph, and withdrawal of this rejection is respectfully requested.

**Obviousness Rejection**

On page 2 of the Office Action, in paragraph 4, claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admissions in the background of the invention and Ishimoto et al US 2002/0191234.

### **The Examiner's Position**

The Examiner's position is that Applicants admit that volume holograms laid on a magnetic layer were old in the art at the time of the invention and that it was recognized that there were wear resistance problems when a volume hologram came repeatedly in sliding contact with a magnetic head. The Examiner indicates that Ishimoto et al teach that volume holograms may be made from the ingredients now claimed. The Examiner asserts that it therefore would have been obvious to optimize the volume hologram to maximize durability during sliding contact with a magnetic head when covering a magnetic recording layer to which magnetic information was to be recorded and read through the volume hologram. The Examiner notes that the comparative example of the present specification uses HRF-800X001, but that the claims are not commensurate with the examples showing improved results over the comparative example.

### **Applicants' Response**

In response, Applicants submit that Ishimoto (US 2002/0191234A1) refers to a volume hologram layer containing a cationic polymerizable compound and a radical polymerizable compound, but says nothing about a magnetic card. That publication is also silent about a volume hologram layer having a glass transition temperature of 50°C or higher, a breaking extension of 0.01% to 30% and a pencil hardness of 3B to 3H in a state with a hologram recorded thereon.

While the Examiner indicates that Applicants admit that a volume hologram layer is soft and wears away readily, Applicants submit that the magnetic card of the present invention is composed of a volume hologram layer having specific physical properties, as set forth at page

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19, line 18 to page 20, line 27 of the specification, which is much more improved in terms of adhesion and wear resistance to a magnetic head, and in counterfeit resistance as well.

Applicants submit that such advantages would not have been obvious over any prior art disclosed in the specification as well as Ishimoto.

Thus, Applicants submit that the present invention is not obvious, and withdrawal of this rejection is respectfully requested.

### Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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